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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,080	07/30/2003	Adam G. Hanes	1449/5	8470
25297	7590	03/01/2005	EXAMINER	
JENKINS & WILSON, PA 3100 TOWER BLVD SUITE 1400 DURHAM, NC 27707			PETERSON, KENNETH E	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,080

Applicant(s)

HANES ET AL.

Examiner

Kenneth E Peterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,9,12-14,16,23,25,27 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,9,12-14,16,23,25,27 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8jan04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant election of claims 1-5,8,9,12-14,16,23,25,27 and 30 is noted. Applicant has cancelled all non-elected claims.

2. Claims 5,8,12-14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, the term "hollow sleeve member" has no basis in the specification, and thus it is not clear what is being referred to.

In claim 8, the term "the sleeve" has no proper antecedent basis in the claims or specification, and thus it is not clear what is being referred to.

In claim 12, the phrase "for rotatably driving a cutting element" is an intended use statement, thus the "cutting element" is considered to be not positively claimed.

However, later in claim 12 is the phrase "first outer wall circumscribes at least a portion of the cutting element", which may lead some to believe that the "cutting element" is positively claimed. Currently it is not clear whether or not the "cutting element" is positively claimed or merely an intended use. Note that claim 1 only refers to a cutter in intended use statements, and thus it is clear that the cutter is not part of the claimed invention. Also note claim 23, which does positively claim a cutter.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,5,12-14,16,23,25,27 and 30 rejected under 35 U.S.C. 102(b) as being anticipated by Byrne '126, who shows a head assembly having a 1st lateral wall (e.g. 35 or 16 or 48 or 55), a 1st transverse shield wall (e.g. 20 or 34 etc.), a 2nd lateral wall (7) having an annular gap filed by a hollow sleeve member or adaptor member (10), a shaft (2) and a cutter (6) having an annular rim (5).

5. Claims 1,2,5,8,12-14,16,23,25,27 and 30 rejected under 35 U.S.C. 102(b) as being anticipated by Schlessmann '934, who shows a head assembly having a 1st lateral wall (e.g. 13), a 1st transverse shield wall (e.g. 19), a 2nd lateral wall (e.g. 46) having an annular gap filed by a hollow sleeve member or adaptor member (e.g. 17), a coaxial adaptor wall (18), a shaft (e.g. 15) and a cutter (23) having an annular rim (22).

6. Claims 1,2,5,8,12-14,16,23,25,27 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Lill '165, who shows a head assembly having a 1st lateral wall (e.g. 43), a 1st transverse shield wall (39), a 2nd lateral wall (vertical sidewalls of 12) having an annular gap filed by a hollow sleeve member or adaptor member (21 or 22,22), a coaxial adaptor wall (23 or 24), a shaft (e.g. 15 or 16) and a cutter (28) having an annular rim (19).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5,8,9,12-14,16,23,25,27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lill '165.

Lill, as set forth above, shows most of the recited limitations.

In regards to claim 3, Lill's 1st and 2nd lateral walls are attached to the same transverse shield wall (39) instead of being attached to two integral transverse shield walls. However, there is no structural difference between a single transverse shield walls and two transverse shield walls that are integral with one another. The courts have long ruled that *"the unity or diversity of parts would depend more on the choice of the manufacturer, and the convenience and availability of the machines and tools.....than on any inventive concept"*. See In re Lockhart, 90 USPQ 214.

Furthermore, Examiner takes Official Notice that it is well known to employ one or two parts in situations such as this. It would have been obvious to one of ordinary skill in the art to have employed two integral transverse shield walls on Lill, instead of just one transverse shield wall, since the courts have ruled this to be obvious and because it is an old equivalent known for the same purpose.

In regards to claims 4 and 9, the bearings 22,22 have a hollow cylindrical portion, a first annular adaptor plate (bottom of 22) and presumably a second annular adaptor plate (top of 22). Since the second annular adaptor plate is not explicitly drawn, Examiner takes Official Notice that it is well known to have such annular adaptor plates

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at the lateral ends of bushing for the purpose of preventing axial sliding. An example of this is the bottom annular adaptor plate on Lill's 22. If it wasn't there already, it would have been obvious to one of ordinary skill in the art to have added a top annular adaptor plate to Lill's adaptor 22 for the purpose of preventing axial sliding.

9. Made of record but not relied on are patents showing pertinent shaft shields.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson at 571-272-4512, on Monday-Thursday, 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached at 571-272-4514. In lieu of mailing, it is encouraged that papers be faxed to 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov> or call the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kp
February 23, 2005



KENNETH E. PETERSON
PRIMARY EXAMINER